

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/523,813 Confirmation No. : 4204
First Named Inventor : Werner Zimmerman
Filed : August 10, 2005
TC/A.U. : 2855
Examiner : Jonathan M. Dunlap

Docket No. : 101619.55842US
Customer No. : 23911

Title : Stress/Extension-Measuring Sensor and Method for Measuring
Stress/Expansion

PETITION TO WITHDRAW FINALITY UNDER 37 C.F.R. § 1.181

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully submit that the Office Action issued on August 22, 2007, was made final prematurely, and accordingly, the finality of this Office Action should be withdrawn.

Regarding the propriety of final rejections on a second or subsequent action on the merits, M.P.E.P. § 706.07(a) states that such actions:

shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

It is respectfully submitted that the new ground of rejection in the Office Action issued on August 22, 2007, was not necessitated by Applicants'

amendment and was not based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 C.F.R. § 1.97(c). Instead, the new grounds of rejection was necessary because the previous grounds of rejection of claim 4 did not in fact render that claim obvious.

Initially, it is noted that Applicants have not filed Information Disclosure Statement during the period set forth in 37 C.F.R. § 1.97(c). Accordingly, the new grounds of rejection cannot be based upon information submitted during this period.

A non-final Office Action was issued on February 15, 2007, rejecting claims 2-4 and 8 under 35 U.S.C. § 103(a) as being obvious in view of the combination U.S. Patent No. 4,975,643 to Buchwald ("Buchwald") and U.S. Patent No. 5,898,298 to Brandsma ("Brandsma").

A Reply was filed on June 13, 2007, amending claim 1 to include the elements of claim 4, which depended directly from claim 1. Claim 1 was also amended to address the rejection under 35 U.S.C. § 112, second paragraph. Prior to this amendment claims 1 and 4 were as follows:

1. Stress/strain measuring sensor for the continuous monitoring of stress/strain conditions, wherein the sensor comprises:

a first inductor; and

at least one other element which is made of piezoelectric or magnetostrictive material, and which comprises at least one

pressure-dependent first impedance or a second impedance and a second inductor,

wherein the second impedance and/or the second inductor are pressure-dependent, so that when the amount of pressure being applied to the at least one other element is changed, the resonant frequency of an electromagnetic resonating circuit that is formed by impedance and inductor changes.

4. Stress/strain measuring sensor according to Claim 1, wherein the at least one other element comprises at least the pressure-dependent second impedance and the second inductor, wherein the pressure-dependent second impedance and the second inductor are connected in parallel and form the electromagnetic resonating circuit, so that when the amount of pressure being applied to the at least one other element changes, the resonant frequency of the circuit shifts.

The amendment to claim 1 to incorporate the elements of claim 4 in the Reply of June 13, 2007, is as follows:

1. Stress/strain measuring sensor for the continuous monitoring of stress/strain conditions, wherein the sensor comprises:

a first inductor of the sensor; and

at least one other element which is made of piezoelectric or magnetostrictive material, and which comprises ~~at least one pressure-dependent first impedance or a second impedance~~ [[and]] connected in parallel with a second inductor to form an electromagnetic resonating circuit of the sensor,

wherein the second impedance and/or the second inductor are pressure-dependent, so that when the amount of pressure being applied to the at least one other element is changed, the resonant frequency of ~~[[an]] the~~ electromagnetic resonating circuit shifts ~~that is formed by impedance and inductor changes.~~

The August 22, 2007, Office Action issued a new grounds of rejection, rejecting claim 1 under 35 U.S.C. § 103(a) as being obvious in view of the combination of U.S. Patent No. 4,660,568 to Cosman ("Cosman") and U.S. Patent No. 4,456,316 to Takeuchi ("Takeuchi").

Because Applicants amended claim 1 to include the elements of dependent claim 4, if the rejection of claim 4 based on the combination of Buchwald and Brandsma was proper, then it would also be a proper rejection against claim 1, which now incorporates the elements of claim 4. Instead of being necessitated by Applicants' amendment, it appears that the new ground of rejection of claim 1, which now incorporates claim 4, was necessitated by the fact that the combination of Buchwald and Brandsma did not disclose or suggest all of the elements of Applicants' claim 4, and in response to Applicants' arguments this was recognized by the Examiner.

Because the new ground of rejection in the final Office Action issued on August 22, 2007, is not necessitated by Applicants amendments of the claims and is not based on information cited by the Applicants in an Information Disclosure Statement filed during the period set forth in 37 C.F.R. § 1.97(c), it is respectfully submitted that the finality of this Office Action is improper and should be withdrawn.

It is believed that no fees are due for this petition. However, if fees are required this paper should be considered as an authorization to charge Deposit Account No. 05-1323 (Docket #038819.50289US) for such fees.

Respectfully submitted,

August 28, 2007



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